

AMENDMENTS TO THE DRAWINGS

The attached "Replacement Sheet" of drawings includes changes to Figure 1.
The attached "Replacement Sheet," which includes Figure 1, replaces the original sheet including Figure 1.

Attachment: Replacement Sheet

REMARKS

Claims 1-25 are now pending in the application. The amendments to the claims contained herein are of equivalent scope as originally filed and, thus, are not a narrowing amendment. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

DRAWINGS

Applicants have attached revised drawings for the Examiner's approval. In the "Replacement Sheet(s)", Figure 1 is revised.

SPECIFICATION

Applicants have amended the specification. Therefore, the Examiner's consideration is respectfully requested.

REJECTION UNDER 35 U.S.C. § 112

The computer entity of claim 25 sends the data. Display of the data occurs at the customer terminal 109. Accordingly, claim 25 has been amended to recite "send data" instead of "serve data."

REJECTION UNDER 35 U.S.C. § 103

The Examiner refers to a combination of TEAS, Lee (US.7,0161,851) and Takano (US 6,434,580). The applicant notes that both Lee and Takano have both proceeded through to grant, which indicates that inventions in this field are not barred from patentability per se.

(I) The examiner states:

"it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the electronic trade mark

application system of TEAS the structure and ability to display country data in which the applicant may be filed as disclosed in Lee so that a party can file in a multiple jurisdictions automatically in accordance with the jurisdiction requirements”.

The applicant submits that there is no teaching in TEAS of data describing a plurality of countries.

The TEAS disclosure is concerned solely with US trade mark applications for federal marks. There is no teaching in TEAS of multiple countries.

Further, there is no suggestion in TEAS of filing a trade mark application in more than one country.

The ordinary person would not be motivated to modify TEAS in view of Lee (US 7,016,851 B) to arrive at the total features of the claimed invention, since Lee does not disclose a user initiated confirmation message which constitutes legal acceptance of a transaction for filing a trade mark application for a mark which has been specified and a number of classes of goods and services which have been specified already.

In figure 3, Lee does disclose requesting fees and approving fees, but this is done without any goods and services or the classification for goods and services being established and there is no mention of establishing a list of goods and services classified into a plurality of different categories. The Lee disclosure is basically concerned with and primarily teaches patent handling. Even in combination with TEAS, Lee would not provide the claimed invention.

(ii) The examiner states:

"it would have been obvious to one of ordinary skill in the art to incorporate into the electronic filing trade mark system of TEAS the electronic receipt taught in Takano so that one would have immediate proof that the document had been correctly received by the office to which it was being transmitted, thus having proof of filing and priority date". Page 6 of action.

As a practical matter, at the time of the invention due to intermittent internet connections, it was quite common to be cut off mid-session when communicating between computers. Therefore, lengthy form filling processes such as disclosed in TEAS and Takano which involved lengthy user sessions resulted in general frustration of the user at the relevant time of invention. As disclosed in the present application, the inventive process is very much simplified compared to Takano or TEAS, with a minimum number of confirmation messages being passed between computer entities.

A combination of TEAS and Takano does not arrive at the claimed features of the presently amended claims.

(iii) The examiner asserts:

"As written the applicants' claims merely display data, allow a user to input data at a user interface, generate and send/ transmit a message/data and receive data.

Moreover, most of the data being displayed, inputted, received, transmitted, etc. is non functional descriptive data." Page 6 of action.

In the claimed invention, since the confirm order message constitutes a legal acceptance of a transaction for a trade mark, the data does perform a function in concluding an agreement.

The applicant notes that objections based on non functional descriptive data have been criticized by the Courts. In Lowry, the US Court of Appeal quoted from Gulack.

"As an initial matter, this court notes that Gulack cautioned against a liberal use of "printed matter rejections" under section 103:

A "printed matter rejection" under Sec. 103 stands on questionable legal and logical footing. Standing alone, the description of an element of the invention as printed matter tells nothing about the differences between the invention and the prior art or about whether that invention was suggested by the prior art.... [The Court of Customs and Patent Appeals], notably weary of reiterating this point, clearly stated that printed matter may well constitute structural limitations upon which patentability can be predicated".

The applicant submits that the data in the presently claimed invention, contrary to being non functional, in fact constitutes structural limitations on which patentability can be predicated.

(iv) The examiner asserts:

"Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate,, but the prior art describes a different descriptive material than the claim, then the descriptive material is non functional and will not be given any patentable weight". Page 7 of action.

In the amended claims, the data transmitted to and from computers is functional, in that it requires response messages which are automatically generated. Taken as a whole, the claimed material is functional, novel, and non obvious to a person of ordinary skills. In particular, the automatic responses require interaction between a computer and an incoming message, and there is therefore functional, novel and non obvious features within the claims.

The examiner asserts:

"Except for the meaning to the human mind, the data does not functionally relate to the substrate and thus does not change the steps of the method as claimed. The subjective interpretation of the data does not patentably distinguish the claimed invention." Page 7 action.

In the amended claims, functional step of generating a confirmation of order display in response to receiving input of individual items of classification, data, trade mark data, and applicant data is a functional step carried out by the computer in response to receiving data. The data therefore performs a function in interacting with a computer. It is not "none functional data".

Similarly, a (user initiated) confirmation message results in a computer responding by automatically generating an acknowledgement message. The acknowledgement message is automatically sent within a same user session. The confirmation message is therefore functional, in the sense that it generates an automatic response from a computer.

Additionally, the features of putting together an automated system, or at least applying levels of automation to the trademark data collection and instructions process make a contribution to the art. There is inventive content in realizing/recognizing the problems with previous manual systems, addressing the problems of such systems in novel ways which optimize keystroke inputs, reduce user frustration, save time and increase user convenience.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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